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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,284	04/11/2000	Hiroshi Satomi	862.C1892	4978

5514 7590 04/10/2007  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
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COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/547,284	SATOMI ET AL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ella Colbert	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 109,111-113,115,117-119 and 121 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 109,111-113,115,117-119 and 121 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____  |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date  
:2/16/07, 12/13/06, 8/29/06, 4/14/06, 1/25/06, 12/23/05, 9/21/05, 09/20/05, 06/14/05, 12/27/04, 3/16/04, 4/10/03, 12/06/04,  
1/15/03, 12/12/02, 08/28/02, 06/11/02, 05/16/02, 10/11/01.

### **DETAILED ACTION**

1. Claims 109, 111-113, 115, 117-119, and 121 are pending in this communication filed 1/08/07 entered as Response After Non-Final Action.

2. The IDS filed 02/16/07 and 12/13/06 have been considered and entered.

3. The requested IDSs filed 10/02/03, 10/10/03, 10/20/03, 10/24/03, 11/05/03, 09/19/05, and 12/11/06 are not found in the file with those dates.

The IDSs found in the file are attached to this Office Action.

4. The amended Specification has been reviewed and accepted.

### ***Claim Objections***

5. Claim 109 is objected to because of the following informalities: Claim 109 is objected to for being in improper method claim format. Claim 109 recites "a receiving step of receiving ...; a first retrieval step of retrieving ...; a second retrieval step of retrieving ...; a setting step of setting a print priority on each ...; a preparation step of preparing a plurality of printing layout examples ...; a selection step of selecting ...; and a creating step of creating printing ...". These claim limitations should be written as follows to be in the proper method claim format: "receiving ...; retrieving for the piece of the first information and its property corresponding to the received unique identifier by searching the first database in a first retrieval step; retrieving for a plurality of pieces of the second information and their properties by searching the second database based on the property of the retrieved piece of the first information in a second retrieval step; setting a print priority on each ...; preparing a plurality of printing layout examples ...; selecting ...; and creating printing ...". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 109, 115, and 121 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Claim 109 recites the "step of receiving a unique identifier from an external apparatus" and the steps that follow are not found in Applicants' Specification. In particular, "receiving a unique identifier", "searching a first database", "searching the second database", "setting a printing priority", "preparing printing layout examples for printing", "selecting a printing layout example", and "creating printing data for printing". Applicants' are respectfully requested to point out in the Specification where these claim limitation elements are found.

Claims 115, and 121 have a similar problem.

Claims 111-113 and 117-119 are also rejected because they depend from a rejected base claim.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 109 recites the limitation " searching the first database" in claim limitation 2 and in claim limitation 3 recites the limitation "searching the second database". There is insufficient antecedent basis for this limitation in the claim. Claims 115 and 121 have a similar problem.

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Claims 109, 115, and 121 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 109, 115, and 121 recite "external apparatus" which is considered vague and indefinite. It is not understood from reading the Specification or the drawings what Applicants' consider to be the "external apparatus or its purpose other than to receive some type of unique identifier.

Claims 111-113 and 117-119 are also rejected because they depend from a rejected base claim.

### ***Conclusion***

Once these issues have been resolved an examination will be given on the claims with the newly added steps.

### ***Inquiries***


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

April 2, 2007

  
JELLA COLBERT  
PRIMARY EXAMINER